

REMARKS

The above amendments and following remarks are submitted in response to the First Office Action of the Examiner mailed March 29, 2004 (i.e., Paper No. 2). Having addressed all objections and grounds of rejection, originally presented claims 1-20 along with newly presented claims 21-25, being all the pending claims, are now deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

The Examiner has objected to the title. In response thereto, Applicants have amended the title. In addition, lines 1-20 of page 1 of the specification were further amended to supply certain information not readily available at the time of filing the subject application.

The Examiner has objected to claims 1, 3, 6-7, 11, 13, 16, and 19. Apparently, the Examiner prefers the spelling, "publicly", to the alternative spelling, "publically". The claims have been amended in accordance with this preference.

The Examiner has objected to the drawings, stating:

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "12-16" have been used to designate client and reference characters "30-36" have been used to designate transaction client.

Though Applicants do not refuse to amend the drawings in response to this objection, they cannot do so because they do not understand the objection. 37 CFR 1.84(p) (4) states:

The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

Applicants believe that they have complied with 37 CFR 1.84(p) (4) in this regard.

The specification at page 10, lines 22-26, states:

Each of the Clients 10, 12, 14 and 16, is a Personal Computer/Workstation having operating system software and application software designed to provide Graphical User Interface (GUI) and communications capabilities which enable the Client to communicate with an associated Server application 18 via a Network 20.

Similarly, the specification at page 11, lines 21-26, states:

The Distributed Transaction Processing System 56 serves data from the Database 28 to the Transaction Clients 30, 32, 34 and 36. The Transaction Clients 30, 32, 34 and 36 are coupled to the Distributed Transaction Processing System 56 via line 38, of which the underlying technology is driven by the application of the Distributed Transaction Processing System 56.

Thus, Clients 10, 12, 14, and 16 are functionally and structurally different from Transaction Clients 30, 32, 34, and 36. Therefore, Clients 10, 12, 14, and 16 have different names and different reference numbers from Transaction Clients 30, 32, 34, and 36. Applicants deem that this practice complies with both the spirit and letter of 37 C.F.R. 1.84(p) (4).

The Examiner has rejected claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite, because the claim utilizes the term "the improvement". The Examiner clearly erroneously describes this term as a limitation. Actually, claim 1 is a "Jepson" style claim specifically authorized by 37 C.F.R. 1.75(e). This claim is to be examined in accordance with MPEP 608.01(m), which states in part:

| **608.01(m) Form of Claims**

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

Thus, the rejection of claim 1 under 35 U.S.C. 112, second paragraph, is respectfully traversed as failing to comply with controlling law.

The Examiner has rejected claims 1-3, 5-7, 11-13, and 16 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,092,114, issued to Shaffer et al (hereinafter referred to as "Shaffer") in view of U.S. Patent No. 6,519,588, issued to Harvey et al (hereinafter referred to as "Harvey"). This ground of rejection is respectfully traversed for the following reasons.

To present a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence of: 1) motivation to create the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all claimed elements within the

alleged combination. The rejection is respectfully traversed, because the Examiner has not provided any such evidence and has therefore has not made a *prima facie* case of obviousness.

Specifically, as to claim 1, the Examiner relies for motivation on a clearly erroneous finding of fact. He states:

However, Harvey teaches a system for electronic data delivery where the data uses XML format (see col. 22 lines 55-67). (emphasis added)

This finding is clearly erroneous. Harvey, column 22, 64-67, actually cited by the Examiner states:

All messages from the Data Originator 241 to Publishing server 246 are normally in Extensible Markup Language (XML) format, except for the actual data transfer. (Emphasis added)

As noted in the highlighted portion of the text, Harvey specifically disclaims "data delivery where the data uses XML format". Instead, Harvey says that "the actual data transfer" is not in XML format. Therefore, the Examiner's attempt at showing evidence of motivation is based upon clearly erroneous findings of fact.

Contrary to controlling law, the Examiner does not even mention reasonable likelihood of success of the alleged combination as required by MPEP 2143. Actually, it is clear that the manually operated "e-mail" exchange system of Shaffer would not be compatible with the automatically operated oil field data collection system of Harvey.

Similarly, the elements of claim 1 are not all found within the alleged combination of Shaffer and Harvey. Contrary to the Examiner's implication, Shaffer has no "transaction request", has no "plurality of formats" for a transaction request, and has no "enterprise server for responding to said transaction request". Therefore, Shaffer has no "generic gateway". The Examiner admits that Shaffer has no XML message. Thus, even if Shaffer had a "generic gateway" (which it does not), it could not have the claimed "generic gateway" which converts the XML message as claimed.

The rejection of claim 1 is respectfully traversed for failure of the Examiner to make any of the three showings required by MPEP 2143 to present a *prima facie* case of obviousness.

Claim 2 depends from claim 1 and is further limited by:

a plurality of adapters interposed between said generic gateway and said user terminal which responsively couples said user terminal to said generic gateway wherein each one of said plurality of adapters corresponds to said one of said plurality of formats

In other words, claim 2 requires a plurality of adapters wherein each permits conversion of a different transaction request format into a form suitable for input to the generic gateway. For whatever reason, the Examiner cites Shaffer, column 3, lines 1-12, which states nothing of this structure. As a result, the rejection of claim 2 is respectfully traversed as based upon the lack of a

prima facie case of obviousness and clearly erroneous findings of fact.

The rejection of claim 5 is respectfully traversed as being incomplete as a matter of law. The Examiner acknowledges that claim 5 depends from claim 4 and therefore contains all of the limitations of claim 4. In paragraph 7 of Paper No. 2, the Examiner admits that the combination of Shaffer and Harvey does not contain all of the limitations of claim 4. Thus, as a matter of law, Shaffer and Harvey cannot contain all of the limitations of claim 5. The rejection of claim 5 is respectfully traversed.

In addition, claim 5 limits the software architecture of the claimed user terminal. The Examiner cites Shaffer column 3, line 64, through column 4, line 5. This citation says nothing of software architecture of any user terminal.

In rejecting claim 6, the Examiner makes similar mistakes to those in rejecting claim 1. The disclosed system of Shaffer simply sends e-mail which is a single direction transfer. The claimed system involves a service request which entails honoring of the service request and generation of a response. Shaffer further has no enterprise server, no generic gateway, etc. Again, the Examiner fails to show motivation for the alleged combination and does not even attempt to address the required showing of reasonable likelihood of success. The rejection of claim 6 is respectfully traversed for failure to make a *prima facie* showing of obviousness.

The rejection of claim 16 is further deficient as a matter of law. The Examiner has clearly not examined claim 16 in accordance with MPEP 2181, et seq. The rejection of claim 16 is respectfully traversed.

Claim 7 depends from claim 6 and is further limited by a "plurality of adapters" coupled in a particular manner. In making his rejection, the Examiner cites Shaffer column 4, lines 12-24, which does not show any adapters coupled in any fashion. The rejection of claim 7 is respectfully traversed.

In rejecting claim 11, the Examiner does not even cite portions of Shaffer relied upon to show the various claimed elements, because he cannot. Shaffer simply does not "compose", "transfer", and "convert" as "service request". In fact Shaffer has no "service request" at all. The rejection of claim 11 is respectfully traversed.

Claim 12 depends from claim 11 and is further limited by transferring the converted service request to the "end service provider". Shaffer discloses an e-mail exchange system. It does not have a "service request" or "end service provider". A service request is a means for a user to "select", "update", "delete", etc. data from a data base (see, for example, page 12, lines 6-7 of the specification or the example discussed at page 18, lines 20-21). Shaffer has no data base, no data base management system, no end

service provider, etc. The rejection of claim 12 is respectfully traversed.

To the "unmotivated" alleged combination of Shaffer and Harvey which has no "reasonable likelihood of success" and does not contain all of the claimed elements, the Examiner alleges the further combination with U.S. Patent No. 6,397,220 ,issued to Deisinger et al (hereinafter referred to as "Deigsinger"). This alleged combination is even less compliant with MPEP 2143. For example, the Examiner states:

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Shaffer by implementing an NT server in a WebTx environment as taught by Deisinger because doing so would transform a request such as a URL from a Web browser into a format which is understandable by a distributed transaction processing system and also transform data returned from the distributed transaction processing system into a formatted response which is returned to the requester and therefore overcoming compatibility issues with a client and a server. (Emphasis added)

This statement is objectionable as a matter of law, because Shaffer has no "request", "URL", "distributed transaction processing system", "data returned", or "compatibility issues". The lack of compliance with MPEP 2143 of this alleged combination is so apparent, the only apparent purpose is to find some of the words of the claimed invention. The rejection of claim 12 is respectfully traversed for failure to make a *prima facie* case of obviousness.

Claim 14 depends from claim 13 and adds further limitations which the Examiner has attempted to find in the alleged further

combination with U.S. Patent No. 6,438,580, issued to Mears et al (hereinafter referred to as "Mears"). As an example that the rejection of claim 14 is inadequate as a matter of law, the Examiner states:

Shaffer teaches a method of processing a transaction comprising composing a service request as a message using one of a plurality of formats (see the rejection of claim 11).

Yet, a review of the rejection of claim 11 shows that the Examiner has made no showing that "Shaffer teaches a method of processing a transaction". In fact he cannot do so because Shaffer says nothing of processing a transaction.

The Examiner concludes his rejection by stating:

It would have been obvious for one of the (sic) ordinary skill in the art at the time of the invention to modify Shaffer by using active page server (sic) format as taught by Mears because doing so would allow the user view (sic) a message using an HTML page using a web browser and therefore overcome the need of an e-mail software. (Emphasis added)

Quite apart from the grammatical difficulties and the clearly erroneous nature of this finding, it is legally irrelevant.

Shaffer column 4, lines 1-3, states:

However, the system and method will be described primarily with respect to the preferred embodiment of exchanging email messages have file attachments.

If the alleged combination were indeed to "overcome the need of an e-mail software", Shaffer would completely fail of its purpose. The rejection of claim 14 is respectfully traversed.

Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatenable over Shaffer in view of Harvey and further in view of U.S. Patent No. 6,442,559, issued to Krishan et al (hereinafter referred to as "Krishan"). This ground of rejection is respectfully traversed for failing to present a *prima facie* case of obviousness. The Examiner has clearly erroneously found that Shaffer "teaches a method of processing a transaction....". Furthermore, he supports this finding with reference to his rejection of claim 11 which adds nothing. Therefore, the addition of Krishan to the alleged combination does not meet the claimed limitations. The rejection of claim 15 is respectfully traversed.

In paragraph 10 of Paper No. 2, the Examiner states:

10. Claims 8-10 and 17-20 do not teach (sic) or define any additional limitations over claims 1-7 and 11-16 and therefore are rejected for similar reasons.

This statement is clearly erroneous as a matter of fact, incorrect as a matter of law, and procedurally inadequate. It is clearly erroneous, because there are limitations found in claims 8-10 and 17-20 which are not found in claims 1-7 or 11-16. It is legally incorrect, because these claims have different statutory bases of patentability. The statement is further procedurally inadequate, because the Examiner is required to address each unique combination of claimed element, which he has refused to do.

Newly present claims 21-25, though differing in scope from originally presented claims 1-20, are deemed patentable for similar reasons as those presented above.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

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By their attorney,

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